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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/018,682 | 04/12/2002 | Toshiya Hamada | 275750US6PCT | 2453 |
| 22850 | 7590 | 11/24/2006 | EXAMINER | |
| C. IRVIN MCCLELLAND OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314 | | | DANG, HUNG Q | |
| | | ART UNIT | | PAPER NUMBER |
| | | | | 2621 |

DATE MAILED: 11/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/018,682 | HAMADA ET AL. | |
| | Examiner | Art Unit | |
| | Hung Q. Dang | 2621 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 12 April 2002.
 2a) This action is FINAL. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-16 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 1-16 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on 12 April 2002 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

| | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date <u>12/19/2001, 05/16/2005</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 11, 15, and 16 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 11 and 15 recite "a program". However, it appears that such would reasonably be interpreted by one of ordinary skill in the art as software, per se. This subject matter is not limited to that which falls within a statutory category of invention because it is not limited to a process, machine, manufacture, or a composition of matter. Software does not fall within a statutory category since it is clearly not a series of steps or acts to constitute a process, not a mechanical device or combination of mechanical devices to constitute a machine, not a tangible physical article or object which is some form of matter to be a product and constitute a manufacture, and not a composition of two or more substances to constitute a composition of matter.

Claim 16 recites a recording medium that merely stores nonfunctional descriptive material. When nonfunctional descriptive material is recorded on some computer-readable medium, it is not statutory since no requisite functionality is present to satisfy the practical application requirement (See MPEP 2106.IV.B.1).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, and 3-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Kikuchi et al. (WO99/38167 – the English translation of which is US Patent 6,005,679 and used as reference hereinafter).

Regarding claim 1, Kikuchi et al. disclose a system for recording and playing back video data (Abstract), comprising: means for generating, from input moving picture data, a thumbnail picture representing said moving picture data, as first thumbnail data, (“thumbnail video encoder 58” in Fig. 40; column 35, lines 50-54; column 37, lines 43-46) and for generating, from said moving picture data, a thumbnail picture of a picture extracted as a characteristic picture (Fig. 36; column 35, lines 50-54; column 37, lines 43-46) and means for recording said first thumbnail data and the second thumbnail data, generated by said generating means as independent groups on a recording medium (“data processor 36”, “disc drive 32” in Fig. 40; column 30, lines 37, lines 5-14; lines 36-40; column 40, lines 16-21; Fig. 36).

Regarding claim 3, Kikuchi et al. further disclose the generating means to generate said first and second thumbnail data as respective data blocks and as one file (Fig. 36; column 30, lines 55-62; column 37, lines 38-42).

Regarding claim 4, Kikuchi et al. further disclose the generating means to generate first management data supervising said first thumbnail data with a number corresponding to the first thumbnail data, and also to generate second management data supervising said second thumbnail data with a number corresponding to the second thumbnail data ("PGCN", "Time Code", and "Start Address" in Fig. 36; column 30, lines 8-14); and said recording means recording said first and second management data in said recording medium (Fig. 36; column 28, lines 7-27).

Regarding claim 5, Kikuchi et al. further disclose said first and second management data include data specifying the format of the picture data of the thumbnail data being supervised ("Picture Size X, Y", which specifies the rectangular shape and dimension of the thumbnail shown in Fig. 36).

Regarding claim 6, Kikuchi et al. further disclose said recording means records picture data of said thumbnail picture contained in said first or second management data in terms of a block of a preset size as a unit (in unit of 32 KB in column 28, lines 28-30; column 29, lines 39-67).

Regarding claim 7, Kikuchi et al. also disclose said recording means records the information representing the referencing destination of said first thumbnail data as a separate file on said recording medium (column 66, lines 43-52).

Regarding claim 8, Kikuchi et al. also disclose said recording means further records the information indicating the referencing destination of said thumbnail picture contained in said second thumbnail data (column 66, lines 43-52).

Claim 9 is rejected for the same reason as discussed in claim 1 above.

Claim 10 is rejected for the same reason as discussed in claim 1 above.

Claim 11 is rejected for the same reason as discussed in claim 1 above.

Regarding claim 12, Kikuchi et al. disclose a reproducing apparatus, comprising: first readout means for reading out management data supervising picture data of a thumbnail picture representing the contents of said picture data in case playback of said picture data is commanded ("MPU 30", "data processor 36", and "disc drive 32" in Fig. 41; column 39, lines 57-59); second readout means for reading out said picture data based on said management data read out by said readout means ("MPU 30", "data processor 36", and "disc drive 32" in Fig. 41; column 39, lines 60-65); third readout means for reading out picture data of a thumbnail picture of picture extracted as a characteristic picture from said picture data, and management data supervising said picture data ("MPU 30", "data processor 36", and "disc drive 32" in Fig. 41; column 39, lines 57-59, 60-65); and fourth readout means for reading out said picture data based on said management data read out from said third readout means ("MPU 30", "data processor 36", and "disc drive 32" in Fig. 41; column 39, lines 60-65).

Claim 13 is rejected for the same reason as discussed in claim 12 above.

Claim 14 is rejected for the same reason as discussed in claim 12 above.

Claim 15 is rejected for the same reason as discussed in claim 12 above.

Regarding to claim 16, Kikuchi et al. disclose a recording medium having recorded thereon first data comprised of picture data, thumbnail picture data of a thumbnail picture extracted from said picture data, indicating the contents of the picture data, and management data for supervising data of said thumbnail picture (Fig. 36;

column 28, lines 9-18, 47-60; column 66, lines 3-22), and second data comprised of thumbnail picture data of a thumbnail picture of a picture extracted as a characteristic picture from said first stated picture data (Fig. 36; column 28, lines 9-18, 47-60; column 66, lines 3-22);

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kikuchi et al. (WO99/38167 – the English translation of which is US Patent 6,005,679 and used as reference hereinafter) as applied to claims 1, 3-16 as discussed above, and further in view of Haneda (US Patent 6,005,679).

Regarding claim 2, see the teachings of Kikuchi et al. as discussed in claim 1 above. However, Kikuchi et al. do not teach the generating means to generate said first and second thumbnail data as respective independent files.

Haneda does teach a system for arranging image data in a file by using a filing system having an image signal input to receive an image signal representative of a frame of image, and a unit for dividing the image into blocks of data (see Abstract), and a storage unit to store the data as an independent file (column 11, lines 14-16; column 18, lines 54-61).

One of ordinary skill in the art at the time the invention was made would have been motivated to incorporate the image filing system taught by Haneda into the recording apparatus taught by Kikuchi et al. because Haneda's image filing system has an advantage of allowing retrieval of recorded image at high speed (column 2, line 66-column 3, line-2).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hung Q. Dang whose telephone number is 571-270-1116. The examiner can normally be reached on M-Th:7:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thai Tran can be reached on 571-272-7382. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Hung Dang
Patent Examiner

HUNG Q. DANG
SUPERVISORY PATENT EXAMINER
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